

claimed composition as a "conditioner," not just a composition. The specification has been amended at page 6 to include the subject matter of original claim 2 as filed. All formal and §112 matters are thus believed to have been resolved.

The asserted obviousness rejection is respectfully traversed. The McGovern prior art is not properly combinable with U.S. Patent No. 5,268,029 to Demangeon et al. for the purpose of a prima facie obviousness rejection, for reasons which are supported by factual assertions in the accompanying Declaration by Edward W. McGovern. Demangeon et al. address asphalt type bitumens, exclusively (see Declaration Paragraph 2), whereas the present invention has to do with emulsions of coal tar pitch-type bitumen coal tar derivatives which are not asphaltic at all. The solubilities of asphalt bitumens are entirely different from the solubilities of coal tar bitumens, see Declaration Paragraphs 3 and 4, which fact in turn mandates the conclusion that teachings as to how to emulsify one--or even whether to try--are inapplicable to any attempts to emulsify the other.

Attached to the Declaration submitted herewith is Mr. McGovern's earlier Declaration, dated September 23, 1993, which was submitted during the Reexamination proceeding which led to the issuance of Reexamination Certificate B1 4,661,378. This attached Declaration highlights how coal tar and asphalt materials--the former being derived from coal and the latter being derived from petroleum--are fundamentally chemically different. It is thus improper to combine a petroleum reference (Demangeon et al.) with a coal tar reference (The McGovern et al.

references of record) because as to solubility, which is all important when emulsification is being discussed, the two entities are not analogous. No proper prima facie showing has thus been made which justifies a prima facie obviousness rejection. With the underlying prima facie case itself flawed, the secondary references cannot supply the missing teachings to teach the claimed invention, notwithstanding their various disclosures concerning emulsifiers in other contexts.

Therefore, as Mr. McGovern concludes in Paragraph 4 of his Declaration, the proportions of constituents and emulsifiers set forth and claimed in the above-identified patent application are not taught by the prior art because the prior art does not address the emulsification of coal tar derivatives at all. Nor is it necessary for Applicant to claim the specific proportion of emulsifiers because the prior art does not even suggest whether coal tar derivatives can be emulsified in the first place.

Reconsideration and allowance of claims 1-12 is respectfully requested.

Respectfully submitted,

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